UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,763	12/12/2003	Kevin Neil Kim	MFCP.108795	8725

45809 7590 02/21/2008

SHOOK, HARDY & BACON L.L.P.
(c/o MICROSOFT CORPORATION)
INTELLECTUAL PROPERTY DEPARTMENT
2555 GRAND BOULEVARD
KANSAS CITY, MO 64108-2613

EXAMINER	
BAUTISTA, XIOMARA L	
ART UNIT	**PAPER NUMBER**
2179	

MAIL DATE	DELIVERY MODE
02/21/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/733,763	KIRN ET AL.	
	Examiner	Art Unit	
	X. L. Bautista	2179	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 December 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-39* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-39* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Reopening Prosecution after Appeal Brief

1. In view of the appeal brief filed on 18 December 2007, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

2. To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) File a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below.

Finality Withdrawn

3. Applicant's arguments, see appeal brief, filed 12/18/2007, with respect to the rejection(s) of claim(s) 1-39 under 35 U.S.C. 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Ball et al and McIntyre et al.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 32-39 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 32 recites a "set of shared media objects...being generated according to a method comprising..." This is clearly not a method claim; this is data structure per se.

These claims do not truly fit any of the four statutory classes of invention, "process, machine, manufacture, or composition matter." They are not even held upon a computer-readable medium, as discussed in the Guidelines for examination, 1995. The claims recite nothing more than information, having some potential use to a computer capable of reading and interpreting them, in a manner analogous to the information content of printed matter, long held to be non-statutory.

Specification

6. The disclosure is objected to because of the following informalities: the specification has an element 112 that is defined as "a set of shared images", as "a set of shared media objects" and as "a set of users". The specification should be revised carefully and correction is required.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-14, 17-29 and 32-39 are rejected under 35 U.S.C. 102(b) as being anticipated by Ball et al (US 2002/0126135 A1).

Claims 1 and 18:

Ball discloses a computer implemented method and system having a messaging client (fig. 28) for presenting a dialog interface (fig. 28) to at least two users (p. 1, par. 0002-0006; p. 2, par. 0046, 0049); a media viewer (p. 19, par. 0258), communicating with the messaging client, the media viewer selectively presenting a set of shared media objects selected by at least one user with control of an image-sharing session (p. 1, par. 0007-0009) to at least one user without control of the image-sharing session (p. 1, par. 0010); and a presentation engine component in the media viewer for presenting all of the media objects within the set of shared media objects to at least one user without control by parallel execution of independent image-processing operations (p. 5, par. 0091-0092, 0095) to convert at least one media object into a thumbnail-sized representation for viewing (p. 19, par. 0255-0258); transfer all of the media objects and the thumbnail-sized representation (p. 20, par. 0259-0265, 0267); and loading all of the media objects and the thumbnail-sized representation to be viewed by the users sharing the media objects (p. 21, par. 0268-0273).

Claims 2, 19 and 33:

Ball teaches a messaging client comprising a network-enabled chat client (p. 19, par. 0258).

Claims 3, 20 and 34:

Ball teaches a dialog interface comprising a mutually viewed chat window presenting typed messages (figs. 28 and 29; p. 20, par. 0260).

Claims 4, 21 and 35:

Ball teaches a set of shared media objects comprising a set of graphical images (p. 2, par. 0049; p. 7-8, par. 0128; p. 21, par. 0268).

Claims 5, 22 and 36:

Ball teaches a set of graphical images comprising a set of digital photographs (p. 1, par. 0004; p. 11, par. 0159).

Claims 6, 23 and 37:

Ball teaches that at least one user maintains control of the shared media objects selectively presented to other users and that control can be transmitted to other users to manipulate the shared media objects (abstract; p. 1, par. 0007-0010; p. 20, par. 0262).

Claims 7, 24 and 32:

Ball teaches a selector tool presenting a set of media objects to select for mutual viewing by the users (p. 1, par. 0007; p. 19, par. 0255; figs. 28-29).

Clams 8, 25 and 38:

Ball teaches a media viewer that is integrated with a messaging client (figures. 28-29;

item 740).

Claims 9, 26 and 39:

Ball teaches a zoom viewer separate from the messaging client (figs. 28-29; item 748).

Claim 10:

Ball teaches a set of shared media objects comprising at least one of an audio sample and a video clip (p. 21, par. 0268-0272).

Claims 11 and 27:

Ball teaches an annotation object presented via the media viewer (p. 9, par. 0143, lines 15-27; p. 10, par. 0151; p. 11, par. 0154, lines 1-7).

Claim 12:

Ball teaches notifications that may include many variations such as using different cursors (pointer) to provide notification as well as changes to the users interface characteristics skins (p. 8, par. 0131); visual or non-visual notifications such as a flashing cursor (pointer) to indicate important information (p. 9, par. 0143).

Claims 13 and 28:

Ball teaches at least two users sharing control of presentation of the set of shared media objects (abstract; p. 1, par. 0007-0010; p. 20, par. 0262).

Claims 14 and 29:

Ball teaches selectable set of shared media objects to view in a media viewer (figs. 28-29; p. 20, par. 0264, 0266; p. 21, par. 0268).

Claim 17:

Ball teaches that the files to be transferred to other users an be different file types including text files, images files, audio files, and presentation (Power Point) files (p. 21, par. 0270).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. **Claims 15 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ball et al US 2002/0126135 A1) and McIntyre et al (US 2003/0236832 A1).**

Claims 15 and 30:

Ball does not teach that any two of the users may select a set of shared media objects to synchronously view, independently of other users. However, McIntyre discloses a method for sharing a compilation of digital images over a communications network (abstract; p. 1, par. 0012; p. 3, par. 0055-0057, 0060; p. 4, par. 0061-0065), wherein two or more users can have their own separate image sharing event, independently of others (p. 8, par. 0085). Therefore, it would have been obvious to modify Ball's method of sharing media objects to include McIntyre's teaching of a sharing media provider that enables different groups of users to synchronously view media objects independently of other users simply because it enables a small group of participants to share media objects of interest to them, and also because, as McIntyre says, this allows for economy of use and provides services that an individual may not be capable or able to provide, and it also allows hosting of a plurality of public image sharing events that can be provided with a sponsoring business, wherein the sponsor or provider can provide high speed communication capabilities that the initiating individual may not have; it can also provide goods and/or services to the users at a professional level; it can provide shipping, and billing services for goods and/or services ordered, etc.

12. **Claims 16 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ball et al (US 2002/0126135 A1).**

Claims 16 and 31:

See claim 1. Ball does not specifically teach an optimized loader for selectively loading

media objects in the set of shared media objects to increase response time. However, Ball discloses a system and method for sharing media objects having a user interface for viewing the shared media object (abstract; figs. 28 & 29; p. 20, par. 0259-0265). Ball teaches a graphical user interface for providing the user with representations of media objects that are loaded when selected by the user; and the interface also having a media viewer to enable the user to view the loaded representation and the original media object. Clicking on the thumbnail image causes the original media object to be loaded, which makes it easier and faster to look at, view, or manage a group of larger images or other type of media objects that otherwise would take too much space in memory and too much time to load or download. Providing the user with only representations of images, audio objects, or video objects, provides an optimized loader since only the selected media object will be loaded to the user's computer and this increases response time. Thus, it would have been obvious to a person having ordinary skill in the art at the time of invention to include software to optimize loading of media objects in Ball's method of providing media objects because a large number of users can be served faster and numerous media objects can be loaded to the users' computers in a shorter period of time, which is advantageous for users, and profitable for businesses, when shopping online.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this

Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to X. L. Bautista whose telephone number is (571) 272-4132. The examiner can normally be reached on Monday-Thursday 8:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on (571) 272-4847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

X. L. BAUTISTA
PRIMARY EXAMINER

WEILUN LO
SUPERVISORY PATENT EXAMINER

xlb
24 January 2008